



IFW/AF

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2883**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Satoshi TATSUURA et al.

Group Art Unit: 2883

Application No.: 10/782,796

Examiner: R. Lepisto

Filed: February 23, 2004

Docket No.: 118798

For: OPTICAL SWITCHING DEVICE AND OPTICAL DEVICE

**REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION
UNDER 37 CFR §1.116**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Corres. and Mail
BOX AF

Sir:

In reply to the March 2, 2005 Office Action, reconsideration of the rejections is respectfully requested in light of the following remarks.

Claims 1-23 are pending in this application.

I. Allowable Subject Matter

Applicants note with appreciation that claims 2-4, 8-16 and 18 are allowable.

II. Rejections Under 35 U.S.C. §103(a)

A. Tian and Fukuzawa

Claims 1, 6-7, 19 and 22-23 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of U.S. Patent Publication No. 2004/0001666 ("Tian") and U.S. Patent No. 5,547,705 ("Fukuzawa"). This rejection is respectfully traversed.

Tian was published January 1, 2004 (§102(a)) and filed in the U.S. Patent and Trademark Office on April 25, 2003 (§102(e)). The present application was filed February 23, 2004. On its face, Tian is thus available as prior art under both 35 U.S.C. §102(a) and §102(e).

However, filed herewith is a verified English-language translation of the priority document that confirms the right of the claims to the September 25, 2003 priority date. As a result, Tian is no longer available as prior art under 35 U.S.C. §102(a). Tian is thus available as prior art only under 35 U.S.C. §102(e).

As such, Applicants submit that Tian cannot be relied upon in a 35 U.S.C. §103(a) rejection. The undersigned has verified that Tian and the present application "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. §103(c). Mainly, at the time of the present invention, both Tian and the present application were owned by Fuji Xerox Co., Ltd. Therefore, because Tian is available only under 35 U.S.C. §102(e), pursuant to 35 U.S.C. §103(c), Tian cannot be relied upon in an obviousness rejection under 35 U.S.C. §103(a).

Fukuzawa alone does not teach or suggest the invention as recited in claims 1, 22 and 23. In particular, Fukuzawa does not teach or suggest that the "optical switching is performed by applying signal light and control light to the organic film, the wavelengths of the signal light and the control light being set in a spectral region on the longer wavelength side in the absorption spectrum of the organic film where the absorbance is not more than 0.3; and by changing a real part or real and imaginary parts of the refractive index of the light control part by using the control light."

Applicants submit that claims 1, 6-7, 19 and 22-23 are allowable. Reconsideration and withdrawal of the rejection are thus respectfully requested.

B. Tian and Fukuzawa and further in view of Shay

Claims 5, 13 and 17 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Tian and Fukuzawa, and further in view of U.S. Patent No. 6,314,215 ("Shay"). This rejection is respectfully traversed.

As explained above, Tian cannot be relied upon in a 35 U.S.C. §103(a) rejection. Shay does not remedy the deficiencies of Fukuzawa discussed above. In particular, Shay does not teach or suggest that the "optical switching is performed by applying signal light and control light to the organic film, the wavelengths of the signal light and the control light being set in a spectral region on the longer wavelength side in the absorption spectrum of the organic film where the absorbance is not more than 0.3; and by changing a real part or real and imaginary parts of the refractive index of the light control part by using the control light" as recited in claim 1, from which claims 5, 13 and 17 depend.

For the foregoing reasons, Applicants submit that claims 5, 13 and 17 are allowable. Reconsideration and withdrawal of the rejection are thus respectfully requested.

C. Tian and Fukuzawa and further in view of Hanson

Claims 20 and 21 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Tian and Fukuzawa, and further in view of U.S. Patent Publication No. 2003/0035972 ("Hanson"). This rejection is respectfully traversed.

As explained above, Tian cannot be relied upon in a 35 U.S.C. §103(a) rejection. Hanson does not remedy the deficiencies of Fukuzawa. In particular, Hanson does not teach or suggest that the "optical switching is performed by applying signal light and control light to the organic film, the wavelengths of the signal light and the control light being set in a spectral region on the longer wavelength side in the absorption spectrum of the organic film where the absorbance is not more than 0.3; and by changing a real part or real and imaginary